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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 000297-203	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>January 27, 2006</u> Signature <u>Thomas F. Marsteller, Jr.</u> Typed or printed name <u>Thomas F. Marsteller, Jr.</u>		Application Number <u>10/707051</u>	Filed <u>November 18, 2003</u>
		First Named Inventor <u>Rosendaul, Michael J.</u>	
		Art Unit <u>2878</u>	Examiner <u>Davienne N. Monbleau</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. <u>29,672</u> Registration number <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34		<u>Thomas F. Marsteller, Jr.</u> Signature <u>Thomas F. Marsteller, Jr.</u> Typed or printed name <u>(972) 233-0939</u> Telephone number <u>January 27, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1460, Alexandria, VA 22313-1460.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

<b>In re Application of:</b>	§	
Michael J. Rosendaul; Wayne	§	
Isbell; James G. Winkel; and, David	§	
W. Buck	§	Group Art Unit: 2878
<b>Serial No.:</b> 10/707051	§	
<b>Confirmation No.:</b> 1050	§	Examiner: Davienne N. Monbleau
<b>Filed:</b> November 18, 2003	§	
<b>For:</b> NIGHT VIEWER	§	
ACCOMMODATING MULTIPLE	§	
IMAGE TUBE TYPES	§	

### Reasons for Review with Form PTO/SB/33

Applicants submit the following reasons justifying a review requested with the accompanying Form PTO/SB/33.

Applicant respectfully requests review of the instant application on the basis of amended Claims 1 and 8. Claims 1 and 11 are the main claims and the remaining claims are directly or indirectly dependent upon those.

This is an appeal from the Final Rejection of October 27, 2005. The Examiner's main ground of rejection is that the claims are unpatentable over U.S. Patent No. 6,150,650 by Bowen et al. (*Bowen*) under 35 U.S.C. §102(b). Additionally, the Examiner has further rejected claims 2, 5-8, 10, 12 and 15-18 under 35 U.S.C. §103 in view of the same *Bowen* reference.

None of the grounds for rejecting the claims can be supported either factually or legally for reasons that will be set forth below.

#### **35 U.S.C. § 102(b) Grounds for Rejection**

*Bowen* describes a device and a method for providing user adjustable variable gain for a specific image intensifier tube type mounted within a night vision device. As *Bowen* teaches, an

"image intensifier tube is subjected to factory calibration for providing an optimum output during operation, wherein said calibration undesirably differs from tube to tube." Col. 2, lines 48-62.

Further, the *Bowen* teaching centers around an MX-10160 image tube with a flex tail that goes into an AN/PVS-14 monocular system. *Bowen* talks about electronics for tube and power supply interfacing to Night Vision Goggle system which resides both inside and outside of the image tube package. See *Bowen*, column 3, lines 36 through 44 and lines 60 through 63.

As conceded by *Bowen*, "one skilled in the art" would know that the electronic package for MX-10160 is "stuffed to the gills" with electronics (there is no extra volume for enhancement electronics). This is the novelty to the *Bowen* patent as some electronics is mounted outside the MX-11769 tube package coupled to a *Bowen* device. See *Bowen*, column 3, lines 60 through 63.

While *Bowen* teaches that multiple image intensifier tube types exist, *Bowen* fails to disclose that a single night vision device may be adapted to use multiple image intensifier tube types as replacements for the original equipment tube. See Cols. 1-2. *Bowen's* device, unlike that of the present invention, only teaches a night vision device that uses a single tube type and the calibration differs from tube to tube. While the *Bowen* tubes may be changed, the tube types are not changed or replaceable, thereby limiting the usefulness in field use of the night vision devices where the same tube type may not always be available.

Independent Claim 1 recites the following most pertinent elements:

1. An adaptive electrical circuit unit for use in a night viewer system of the type that includes an image intensifier tube and a compatible power source electrically connected to the image intensifier tube, the invention comprising:

a voltage gain detection circuit unit operably connected to the image intensifier tube for detecting **multiple selected types of image intensifier tubes** and

producing an output gain signal appropriate to the **detected image intensifier tube** for controlling the gain of the detected image intensifier tube.

As raised by Applicants in Amendments submitted August 23, 2005, and December 23, 2005, since such use of multiple image tube types in the night vision device of the Applicants' invention as claimed is not disclosed or suggested by *Bowen*, the claimed structure of the present invention is neither identical to nor disclosed by the *Bowen* device.

In the Final Rejection, page 2, the Examiner concluded that *Bowen* disclosed a system for "detecting multiple selected types of image intensifier tubes" referring to *Bowen* claim 1, lines 6-11. However, *Bowen* teaches only a structure in which "one tube is substituted for another," not a plurality of types of tubes. Therefore, *Bowen* cannot anticipate the present claimed invention.

Moreover, the allegedly prior art devices lack the functional characteristics of the claimed structure of the independent claims in the present application. The cited device does not have the capability to accept *multiple image intensifier tube types* and to *provide the proper gain for the type of tube used or selected*.

Even if the *Bowen* patent incidentally showed a similar arrangement of parts, if that arrangement is neither claimed nor designed to perform the function of the present invention, *Bowen* cannot act as an anticipation.

### **35 U.S.C. § 103 Grounds for Rejection**

The Examiner has also rejected the Claims under 35 U.S.C. § 103(a) as being unpatentable over *Bowen*.

Applicants' invention is directed toward solving the disadvantage that night vision devices heretofore were designed to accept a single type of image intensifier tube. Prior to the

present invention the user of a night vision device had to replace the installed image intensifier tube with a tube of the same type, which may not always be readily available. Since night vision devices are often used by members of the military during operations and maintenance supplies may be limited, there is a need for the night vision device to be adapted to use another tube type that might be available.

Even if one were to insert (and there is no suggestion of doing so in *Bowen*) another image intensifier tube type in *Bowen*'s night vision device, the night vision device would not have the independent capability to determine the type of replacement tube and establish the proper electronic signals necessary for operation of that specific tube type different than the tube type being replaced.

As raised by Applicants in Amendments submitted August 23, 2005, and December 23, 2005, it is improper to use hindsight having read the Applicant's disclosure to "pick and choose" among isolated prior art references to disparage the claimed invention. Even where an invention is, as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the combination. Thus, the mere fact that the prior art *may be modified* in the manner suggested by the Examiner does not make the modification obvious unless the prior art *suggested* the desirability of the modification. Finally, it is the invention as a whole that is important. Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness.

Applicant respectfully submits that *Bowen* does not disclose, teach, or suggest a means to detect multiple selected types of image intensifier tubes as recited by amended Claim 1 and Claim 11.

The rejection should also be removed because there is no teaching or disclosure **in the prior art of record** that would have suggested to the artisan the obviousness of providing a means to detect multiple selected types of image intensifier tubes.

In order to establish a prima facie case of obviousness, the prior art teachings must be sufficient to suggest making the substitution or modification necessary to make the claimed invention to one of ordinary skill in the art, In re Lahu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984), in the absence of applicant's own disclosure. The motivation to make a specific structure

"is not abstract, but practical, and is always related to the properties or uses one skilled in the art would expect the [structure] to have, if made."

In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979).

Dependent Claims 2-10 and 12-18 that depend from independent Claim 1 or 11 are also not made obvious by *Bowen* because they include the limitations of Claim 1 or 11 and add additional elements that further distinguish the art. Therefore, Applicants respectfully request that Claims 1-18 be allowed.

#### **Conclusion**

Applicants consequently submit that the pending claims are patentably distinct from *Bowen*. In light of the reasons set forth above, Applicants respectfully request review and allowance of Claims 1-18.

If there are matters which can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner(s) to call the attorney at the Examiner's convenience.